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MITCHELL R. SWARTZ, SCD, MD, EE
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In Re: Mitchell R. Swartz
Serial No. 09/750,480
Filed: December 28, 2000
For: METHOD AND APPARATUS TO MONITOR LOADING USING VIBRATION

: Decision on Petition under
: 37 C.F.R. 1.181

This is a decision on the petition filed February 03, 2004 under 1.181 to correct a situation with respect to Office communications mailed November 18, 2003 and January 14, 2004.

The Petition is **GRANTED-IN-PART** to the extent indicated below.

On July 9, 2003 the Office mailed a non-final office action. Applicant responded on October 24, 2003. A final rejection was issued on January 13, 2004. Applicant appealed the rejections on May 13, 2004 and submitted a first appeal brief on July 7, 2004. On September 27, 2004 a notice of defective appeal brief was mailed to the applicant.

Applicants lengthy petition is summarized into four main issues, namely 1.) Does the application contain new matter? 2.) Is the examiner's argument with respect to the 35 USC 112 2nd rejection unresponsive? 3.) Are the examiner's arguments with respect to the 35 USC 102 and 103 rejections unresponsive? 4.) Are the examiner's arguments with respect to the 35 USC 101 and 112 1st rejections unresponsive?

The four issues are discussed and decided separately as follows:

1.) Is the term "loading" in the current application new matter?

A summary of the matter issue identified by the examiner is best taken from the Office action mailed on July 9, 2003 wherein the examiner stated:
"A review of the specifications of the two applications revealed that reference in the parent application to "electrochemically induced nuclear fusion reactions" (e.g., see p. A161, Appendix A) has been changed in the current application to "loading" (e.g. see p. 2 of the specification), "Nuclear fusion cell" (e.g., see p. A166 of Appendix A) has been changed to "loading system" (e.g., see p. 6 of the specification), "cold fusion reactor' (e.g. see p. A167 at Appendix A) has been changed to "reactor" (e.g., see p. 9 of specification), etc. Therefore, a) Unless the applicant, who can be his own lexicographer, declares that these two terms have identical

meaning this change in terminology from "nuclear fusion" to "loading" represents new matter. as such, the current application does not qualify as a continuation of the parent and therefore entitled only to the priority of its filing date, i.e., 12/28/2000."

In response, in the response filed on October 24, 2003, applicant indicated that support for the subject matter can be found in the claims of the parent application.

A review of those claims indicates that applicant had sufficient support for the subject matter now disclosed.

The petition with respect to the new matter issue is GRANTED.

Therefore, the rejection under 35 USC 112, 1st paragraph, in the Office action of January 13, 2004 with respect to this issue is hereby withdrawn.

2.) The examiner has been unresponsive to applicants arguments related to the 35 USC 112 2nd paragraph rejection

The rejection included the following statement:

Claims 1, 8 and 17 recite the limitation, "mechanically coupling said material." The claims are vague, indefinite and incomplete as to what the material is coupled to. Claims 1 and 10 recite the limitation, "providing means to follow the frequency of said vibration." The claims are vague and indefinite as to what is meant by the term, "to follow." Claims 14, 15 and 16 recite the limitation, "second mass". There is insufficient antecedent basis for this limitation in the claims because there is no "first mass" to provide reference for this so-called "second mass"..

A review of the applicant's comments, especially those outlined in the instant petition and the examiners response in the Office action mailed on January 14, 2004 has been made. The arguments provided by the applicant are mere generalizations in nature and in some instances are directed to the rejection of the claims in the parent application, rather than the issue at hand. The examiner appears to have addressed all the substantive issues raised by the applicant. Although the examiners comments are not as voluminous as applicant's response, the main points have been adequately addressed. The examiner does not need to address applicant's comments that are merely general in nature without any substantive information or rebuttal of specific issues. An example of such a comment is seen on page 8 of the instant petition entitled " PURPORTED INDEFINITENESS". A proper response to a rejection is defined by 37 CFR 111(b).

"(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to

render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section."

With respect to the various affidavits, etc. the examiner appears to have addressed the fact that most of these documents are directed to a prior application that was previously decided by the Federal Circuit Court. In so much that the Court ultimately weighed the evidence and took these affidavits into consideration, they are moot with respect to the issues in that application.

A proper response would be addressing *specifically why* the claims are definite by addressing the examiners concerns and how the claims overcome those concerns.

The petition on this issue is DENIED as examiner has adequately addressed the substantive merits of applicant's response.

3.) The examiner has been unresponsive to applicants arguments related to the 35 USC 102 and 103 paragraph rejections.

In that the new matter rejection has been withdrawn, the dates of the references used in the prior art rejections are not available under 35 USC 102 and 103. Therefore, these rejections under 35 USC 102 and 103 made in the Office action of January 13, 2004 are also hereby withdrawn.

The petition on this issue is DISMISSED as Moot.

4.) The examiner has been unresponsive to applicants arguments related to the 35 USC 101 and 112 1st paragraph rejections.

Upon review of the examiners rejection, applicants response and the examiners final rejection it has been determined that the examiner has responded to the substantive portions of applicants remarks. In that many of applicant's arguments take issue with the merits of the rejection, many of these issues are not before the director of this Technology Center, but rather are matters for the Board of Patent Appeals.

The petition on these issues is DENIED.

After mailing of this decision, the application will be returned to the examiner for reconsideration of the application in view of the holdings in this decision. The examiner will make a determination whether to withdraw the finality of the Office action mailed January 13, 2004 or continue with the appeal process with the remaining appealable issues in this application.

Any comments or concerns regarding this matter should submitted *in writing* to the attention of Michael Carone, Supervisory Patent Examiner, Art Unit 3641.

The petition is **GRANTED-IN-PART**.

Donald T. Hajec, Director
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Mc/snm : 10/20/04